

Remarks/Arguments:

This is a reply to the non-final office action of October 3, 2007.

Drawings

The drawings were objected to because of the re-use of the same reference numbers in different embodiments. We have amended the drawings on the enclosed Replacement Sheets by adding multiples of ten to distinguish the various corresponding elements. References O and H have been deleted from the specification.

Novelty

In the present office action, the examiner has denied novelty of the claims on file over US 7,040,663 (Plaschka). Although we believe that claim 16 as it stood was novel over Plaschka, we nevertheless have amended the claim to further clarify the differences between Plaschka and the present invention. For that reason, we have combined claims 16 and 17, as well as claims 25 and 26.

The present invention addresses the concerns of issuing authorities about the sources of the different elements which are put together in a manufacturing of currency or other security documents (see para. [0008] of US 2007/0980533, which is the US publication of the present application; in the following we will refer to paragraph numbers of the publication). In other words, the present invention concerns the possibility of tracing the authenticity of the various constituents of security documents such as bank notes. This would allow for a better control and customization of bank note substrate manufacturing for determined currency editions and denominations, and therefore would help the issuing authorities to fight against currency paper and ink diversion (section [0013]).

According to the present invention, this problem has been solved by putting in different constituting parts of a security document, security elements having identifiable properties. These identifiable properties are the first and second authentication features of the security document. The main idea of the present invention is, however, that said first and second security element are materially the same and are selected from a list of substances mentioned in claim 16. By combining claims 16 and 17 we have now introduced into claim 16 the feature that the first and further security elements are materially the same.

By comparing the identifiable properties of the first and second security elements, the authenticity of the different constituting parts where said first and second security element are present can be verified. This possibility of comparison is the third security feature of the security document. This is the security feature which was not previously known in the art.

Turning now to Plaschka, we respectfully submit that also this reference does not disclose the subject matter of amended claim 16. Plaschka suggests providing a document of value with a security element which comprises two different materials. First, for optical verification of the authenticity of the document, at least one optically variable material is provided. In addition, at least one machine-readable feature substance is provided. The additional machine-readable feature substance must be chosen such as not to impair the visible optically variable effect of the optically variable material (see, e.g., claim 1). Moreover, claim 1 of Plaschka clearly states that the two different materials should be disposed in one layer (see e.g. claim 1).

Applicant respectfully submits that the teaching of Plaschka completely fails to anticipate the subject matter of the present invention. Plaschka does not suggest the use of two different security elements which are materially the same, have the same identifiable properties and are provided in different constituting parts of a security

document. In contrast, as mentioned above, Plaschka suggests the use of two different materials having different authentication features in one layer.

It is not surprising that Plaschka does not anticipate the claimed invention. Plaschka does not address at all the problem underlying the present invention (as explained above), but rather is based on a problem of providing a document of value with an optically variable security element which has not only have a visually well recognized optically variable effect, but also improved machine-readability (Plaschka, column 1, lines 48 to 52). In other words, Plaschka wants to improve the protection of a security document against counterfeiting by not only relying on an optically visible security feature (provided by optically variable pigments), by additionally providing a machine-readable feature. Plaschka is not related at all to the problem of tracing the authenticity of the various constituting parts of such a document of value. The present invention aims to provide protection against counterfeiting on a completely different level: not the security features of the security document per se should be improved, but rather it should be guaranteed that the constituting parts of such a security document are from reliable and authorized sources.

In the office action, the examiner referred to figures 1 and 2 for allegedly proving anticipation of the subject matter of claim 16. However, applicant respectfully submits that the examiner's approach is not appropriate. Figures 1 and 2 of Plaschka are related to separate embodiments of Plaschka's invention. In figure 1, there is only one security element on the security document. This is the print 4 which comprises an optically variable material as well as at least one machine-readable feature substance. In other words, in the embodiment shown in figure 1, the two security features which are different anyway (and not materially the same!) are provided in the same constituting part of the security document (see column 5, lines 18 to 38). Applicant respectfully submits that the entire discussion of figure 1 in Plaschka (column 5, lines

18 - 55), does not teach that the security thread 2 should comprise the same security features as the print 4. In view of the lack of such a disclosure, claim 16 is novel.

In figure 2, another embodiment of Plaschka's invention is shown. Here, the security features are present (but only present) in a security thread similar to the one shown in figure 1. Again, there is no teaching in Plaschka that the specific security thread shown in figure 2 should be used in combination with the security print 4 shown in figure 1.

Applicant also respectfully submits that the examiner's interpretation of figures 1 and 2 is in contrast to the entire disclosure of Plaschka. If one looks at the summary of the invention in column 2, lines 31 to column 3, line 13, one clearly sees that Plaschka teaches the possibility to provide the security element (which, as noted, consists of two different security features which are not materially the same) in e.g. a color layer, a thread, a band, a plastic foil, a plastic pellet or a multi-layer transfer element. However, each discussion of such an individual possibility is introduced with the wordings "alternatively" or "another embodiment". Plaschka does not teach that the same security element should be present simultaneously in different constituting parts of a security document. Plaschka teaches that only one security element be present on the security document. It is correct that such security element can be in different constituting parts, but only in one constituting part on one security document.

Applicant is of the opinion that one should not leave the four corners of Plaschka's disclosure. In hindsight, it may appear attractive to derive from Plaschka the idea to use his security element simultaneously in different constituting parts. However, this is clearly not what Plaschka is teaching or suggesting.

In summary, applicant believes that the invention described in claim 16 is both novel and non-obvious over Plaschka.

Claim 23 was rejected as obvious in view of Plaschka and Norman (US 5,478,629). It is our opinion that already amended claim 16 is clearly patentable. Norman at best only teaches the separate feature of claim 23; however, Norman does not overcome the above-noted deficiencies of Plaschka with respect to parent claim 16.

We believe the claims now presented define an invention which is patentable over the prior art of record, and that this application is now in condition for allowance.

Respectfully submitted,

/Charles Fallow/

Charles W. Fallow
Reg. No. 28,946

Shoemaker and Mattare, Ltd.
10 Post Office Road - Suite 100
Silver Spring, Maryland 20910

January 29, 2008